

No. 11769.

IN THE  
United States Circuit Court of Appeals  
FOR THE NINTH CIRCUIT

---

ACHILLE BIANCHI and MARLO PACKING CORPORATION,  
*Defendants-Appellants,*

*vs.*

ARTHUR E. H. BARILI,

*Plaintiff-Appellee.*

---

ARTHUR E. H. BARILI,

*Plaintiff-Appellant,*

*vs.*

ACHILLE BIANCHI and MARLO PACKING CORPORATION,  
*Defendants-Appellees.*

---

ANSWERING BRIEF FOR PLAINTIFF-  
APPELLEE, ARTHUR E. H. BARILI.

and

REPLY BRIEF FOR PLAINTIFF-APPELLANT  
ARTHUR E. H. BARILI.

---

ALAN FRANKLIN,

356 South Spring Street, Los Angeles 13,

BOYKEN, MOHLER & BECKLEY,

W. BRUCE BECKLEY,

723 Crocker Building, San Francisco,

*Attorneys for Plaintiff-Appellee and Plaintiff-Appellant,  
Arthur E. H. Barili.*



TOPICAL INDEX TO ANSWERING BRIEF FOR  
PLAINTIFF-APPELLEE, ARTHUR E. H. BARILI

	PAGE
Preliminary statement .....	1
The invention in suit.....	2
Argument .....	5
The prior art.....	6
File wrapper amendments.....	31
Validity .....	37
Infringement .....	38
Alleged limitation of action.....	47
Conclusion .....	48

## TABLE OF AUTHORITIES CITED

CASES	PAGE
Altoona Publix Theatres v. American Tri-Ergon Corp., 284 U. S. 484 .....	30
Bell Telephone Case v. American Telephone Co., et al., 22 Fed. 309 .....	7, 30
Cantrell v. Wallich, 117 U. S. 690, 6 S. Ct. 970, 29 L. Ed. 1017 .....	7
Christian, In re, 308 O. G. 231.....	35
Diamond Rubber Co. v. Consol. Tire Co., 220 U. S. 428.....	10
France Mfg. Co. v. Jefferson Electric Co., 106 F. (2d) 605; cert. den. 309 U. S. 657, 84 L. Ed. 1006.....	31
Goodman v. Paul E. Hawkinson Co., 120 F. (2d) 167.....	36
Hildreth v. Mastoras, 257 U. S. 27, 66 L. Ed. 112.....	5
Hoe v. Goss, 30 F. (2d) 271.....	29
Kennicott Co. v. Holt, 230 Fed. 157.....	35
Klein v. Russel, 19 Wallace 433.....	23
Krementz v. S. Cottle Co., 148 U. S. 558.....	19
Leads & Catlin v. Victor Talking Machine Co., 213 U. S. 318....	10
Loom Company v. Higgins, 105 U. S. 580.....	10
McClain v. Ortmayer, 141 U. S. 425.....	23
McMahon v. Tyng, 14 Allen (96 Mass.) 167.....	25
Schick Dry Shaver, Inc. v. Dictograph Products Co., 89 F. (2d) 643 .....	36
Schick Dry Shaver, Inc. v. R. H. Macey & Co., Inc., 111 F. (2d) 1018 .....	36
Searchlight Horn Co. v. Victor Talking Mach. Co., 261 Fed. 395 .....	7, 30
Sherman Clay & Co. v. Searchlight Horn Co., 214 Fed. 86....	17, 19
The Portland Telegram v. New England Fiber Blanket Co., 38 F. (2d) 780.....	21, 22
Topliff v. Topliff, 145 U. S. 171.....	23, 30

	PAGE
Westinghouse v. Boyden Power Brake Co., 170 U. S. 537, 42 L. Ed. 1136.....	5
Wheeler Salvage Co. v. Rinelli et al., 205 Fed. 717.....	35
Wilson & Willard Mfg. Co. v. Bole, 227 Fed. 607.....	7, 30
Wire Tire Machinery Co. et al. v. Paper Box Corp., Ltd., et al., 102 F. (2d) 543, 41 U. S. P. Q. 66.....	37
Yesbera v. Hardesty Mfg. Co., 166 Fed. 120.....	10
Miller v. Eagle, 151 U. S. 186, 38 L. Ed. 121, 14 S. Ct. 310.....	43

#### STATUTES

Revised Statutes 4921 (35 U. S. C., Sec. 70).....	47
---	----

#### TEXTBOOKS

Lewis, Astronomy Ancients i (1862), Sec. 1.2.....	34
The Oxford English Dictionary.....	34
Twentieth Century Dictionary.....	34
1 Walker on Patents (Deller's Ed.), Sec. 41, p. 216.....	20
1 Walker on Patents (Deller's Ed.), Sec. 63, pp. 300-302.....	7, 30
2 Walker on Patents (Deller's Ed.), Sec. 163, p. 757.....	35
2 Walker on Patents (Deller's Ed.), Sec. 241, p. 1206.....	23
2 Walker on Patents (Deller's Ed.), Sec. 247, p. 1211.....	5
2 Walker on Patents (Deller's Ed.), Sec. 247, p. 1212.....	20, 21
2 Walker on Patents (Deller's Ed.), Sec. 249, p. 1218.....	32
2 Walker on Patents (Deller's Ed.), Supp., Sec. 249, p. 110.....	31
3 Walker on Patents (Deller's Ed.), Sec. 450, p. 1680.....	46
3 Walker on Patents (Deller's Ed.), Sec. 463, pp. 1699-1700....	42
3 Walker on Patents (Deller's Ed.), Sec. 464, pp. 1700-1701....	43
3 Walker on Patents (Deller's Ed.), Sec. 466, p. 1703.....	42
3 Walker on Patents (Deller's Ed.), Sec. 470, p. 1708.....	43
3 Walker on Patents (Deller's Ed.), Sec. 701, p. 2009.....	7
Webster's New International Dictionary.....	34



No. 11769.

IN THE

# United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT

---

ACHILLE BIANCHI and MARLO PACKING CORPORATION,  
*Defendants-Appellants,*

*vs.*

ARTHUR E. H. BARILI,

*Plaintiff-Appellee.*

---

## ANSWERING BRIEF FOR PLAINTIFF- APPELLEE, ARTHUR E. H. BARILI.

---

### Preliminary Statement.

This is a suit in equity for infringement of United States Letters Patent No. 1,844,142, issued to the plaintiff-appellee, Arthur E. H. Barili, February 9, 1932, for an invention in a Stuffed Pastry Machine [Tr. pp. 2-4]. The District Court below ordered, adjudged and decreed that said Letters Patent in suit, and particularly claim 4 thereof, are good and valid in law; that the defendant-appellant, Achille Bianchi, has infringed claim 4 of said Letters Patent, by manufacturing and selling stuffed pastry machines of the type exemplified in Defendants' Exhibit B; that the defendant-appellant, Marlo Packing Corporation, has infringed claim 4 of said Letters Patent, by using stuffed pastry machines of the type exemplified in Defendants' Exhibit B; that a final injunction may issue forthwith against said defendants-appellants; and that plaintiff-appellee may recover his costs of this suit [Tr. pp. 27-29].

### The Invention in Suit.

The invention protected by the patent in suit, and particularly claim 4 of said patent, is a Stuffed Pastry Machine, and it is particularly useful for making *ravioli*, filled confectionery and other elementary products. Claim 4 appears on page 3 of the patent [Pltf. Ex. No. 1; Tr p. 50], and on page 179 of the Transcript of Record.

The invention includes generally a pair of intergearing forming and cutting rollers, indicated 11 and 12 in the patent; means, such as a table 3 and feed rollers 5 and 6, and a table 4 and feed rollers 7 and 8, for feeding two sheets of dough, indicated 9 and 10; and a hopper indicated 20, into which stuffing is deposited for delivery between said two sheets of dough, as said dough sheets are fed downwardly over and between said forming and cutting rollers 11 and 12, whereby ravioli or other stuffed products are formed and cut square-shape by said rollers 11 and 12, as shown in Figs. 2 and 3 of the drawing of the patent in suit [Pltf. Ex. 1].

The machine is driven by power, such as an electric motor (not shown), applied to a drive shaft 40, as shown in Fig. 1 of the patent drawing. The forming and cutting roller 12 is driven by the shaft 40 through sprockets and a chain 41, and the forming and cutting roller 11 is driven by roller 12 through intermeshing gears 42 and 43 on the shafts of said rollers 12 and 11, respectively. The feed roller 8 is driven by the roller 12 through sprockets on said rollers and a chain 39. The feed roller 7 is driven



by roller 11 through sprockets on said rollers and a chain extending over said sprockets. The feed roller 5 is driven by the roller 12 through sprockets on said rollers and a chain 44 extending over said sprockets. The feed roller 6 is driven by the roller 11 through sprockets on said rollers and a chain extending over said sprockets.

The forming and cutting rollers 11 and 12 are of novel construction. Referring to Fig. 4 of the patent drawing it will be seen that the roller 11 is formed with a plurality of annular rows of molds  $11^a$  and  $11^b$ , there being two of said rows of molds shown, but there may be any suitable number of rows of said molds. On the roller 11 are mounted rows of blade cutters, 15 and 16, extending longitudinally or axially of the roller, in the partitions between the molds  $11^a$ , and in the partitions between and molds  $11^b$ . On the roller 12 are mounted annular peripheral blade cutters 13 and 14, and these cutters are positioned to slit the dough or paste sheets 9 and 10 lengthwise as they pass between the forming and cutting rollers 11 and 12. It is important to note that, when the machine is in operation, the axially disposed blade cutters 15 and 16 on the roller 11 pass between the annular peripheral cutters 13 and 14 on the roller 12. The roller 11 (Figs. 4 and 5 of the drawings of the patent in suit) is formed with two annular end sections 30 and 31, of substantial width at the outer sides of the rows of molds  $11^a$  and  $11^b$ , respectively, and said roller is formed with straight longitudinal sections 32, of substantial width, between the molds  $11^a$ , and with straight

longitudinal sections 33, of substantial width, between the molds 11b, in which longitudinal sections 32 and 33 are secured the longitudinal blade cutters 15 and 16. During rotation of the rollers 11 and 12, when the machine is in operation, the annular end cutters 13 of roller 12 contact the peripheral surfaces of the annular end sections 30 and 31 of the roller 11, and the intermediate annular cutter 14 of roller 12 contacts the peripheral surface of the intermediate annular section 34 of roller 11, while the longitudinal cutters 15 and 16 of roller 11 contact the peripheral surface of the roller 12 for cutting the ravioli square shape, as shown in Figs. 4, 2, and 3 of the drawings of the patent in suit [Pltf. Ex. 1]. The substantial width of the annular sections 30, 31 and 34, and the longitudinal sections 32 and 33 of the roller 11 is to provide sufficiently *wide* flanges around the stuffing pockets of the ravioli, when the dough or paste sheets 9 and 10 are cut by the cutters 13, 14, 15 and 16, so that said flanges, when pressed firmly together between the rollers 11 and 12, will close the edges of the stuffing pockets tightly and *effectively seal* the stuffing in the ravioli, thereby preventing the rollers 11 and 12 from pulling the ravioli open, as the same are drawn between said rollers and cut by the cutters 13, 14, 15 and 16 on said rollers, as illustrated in Figs. 1, 2, 3 and 6 of the drawings of the patent in suit.

## ARGUMENT.

The appellees' invention, as covered by the patent in suit, and particularly by claim 4 of said patent, is the *first practical automatic continuously-operatable, mass production machine in the art, for producing ravioli without waste*, and is accordingly a *primary or pioneer* invention, because *it first successfully performed the new function of producing ravioli automatically and continuously on a large scale, and without waste*, to meet the demand of large modern packing plants. Appellee is prepared to prove on an accounting that his machine, operated by *one* man, produces 1200 cases of ravioli per day, whereas the most efficient competing machine, operated by *two* men, could produce only 100 cases of ravioli per day.

“A primary or pioneer invention, covering a function never before performed, a wholly novel device, or one of such novelty and importance as to mark a distinct step in the progress of the art, is entitled to a broad range of equivalents.”

Walker on Patents (Deller's Ed.), Vol. 2, sec. 247, p. 1211.

*Westinghouse v. Boyden Power Brake Co.*, 170 U. S. 537, 561, 42 L. Ed. 1136;

*Hildreth v. Mastoras*, 257 U. S. 27, 34, 36, 66 L. Ed. 112 (1921).

“Even though an invention be not a pioneer, if it marks a decided step in the art, it will be entitled to the benefit of the rules of equivalents, though not so liberal a degree as if the invention were of a primary character.”

Walker on Patents (Deller's Ed.), Vol. 2, sec. 247, p. 1212.

Appellee's invention, covered by the patent in suit, in stepping up production of ravioli far beyond the capacity of any competing machine, certainly marked a decided step and advance in the art. The advent of the appellee's invention revolutionized the ravioli manufacturing industry.

### The Prior Art.

Only two prior patents, to-wit: Holmes No. 518-454, issued April 17, 1894, and Evans No. 1,094,320, issued April 21, 1914, set up in appellants' answer as a defense of prior invention, were introduced in evidence at the trial, as Defendants' Exhibits D and E [Tr. p. 105]. These two patents were cited by the Patent Office during the prosecution of the application for the patent in suit, as appear on page 17 (Paper No. 2) and page 27 (Paper No. 6) of the File Wrapper and Contents of Barili patent in suit, Defendants' Exhibit C, but upon careful examination, and after due consideration of said prior patents, the Patent Office found that said patents did not anticipate the Barili invention, and allowed the claims of the Barili patent in suit. The arguments of the solicitor of the Barili patent against said Holmes and Evans patents, appearing on pages 20, 26, 31, 32, 33, 36, 38, 40, 42 and 44 of the File Wrapper and Contents of the Barili patent, clearly and convincingly pointed out to the Patent Office the novelty and patentability of the claims of the Barili patent in suit over said prior Holmes and Evans patents.

The granting of Letters Patent in suit is *prima facie* evidence of the validity thereof, and raises a strong presumption of validity of said Letters Patent, which can be

overthrown only by proof to the contrary beyond a reasonable doubt.

“Either Letters Patent, or such a copy thereof, is *prima facie* evidence of the validity of the Letters Patent.”

Walker on Patents, Deller's Ed., Vol. 3, sec. 701, p. 2009;

*Cantrell v. Wallich*, 117 U. S. 690, 6 Sup. Ct. 970, 29 L. Ed. 1017.

“The burden of proof of a want of novelty rests upon him who avers it, and every reasonable doubt should be resolved against him. Novelty can only be negated by proof which puts the fact *beyond a reasonable doubt*.”

Walker on Patents, Deller's Ed., Vol. 1, Sec. 63, pp. 300-302;

*Wilson & Willard Mfg. Co. v. Bole*, 227 Fed. Rep. 607 (C. C. A. 9th, Circuit);

*Bell Telephone Case v. American Telephone Co., et al.*, 22 Fed. Rep. 309;

*Searchlight Horn Co. v. Victor Talking Mach. Co.*, 261 Fed. Rep. 395 (C. C. A. 9th Circuit).

*The machine covered by the Holmes patent No. 518,454 could not produce ravioli.* Said patent covers a machine for producing articles of *tubular* form, or articles consisting of an *elongated tubular* envelope and a suitable filling, such as a *stuffed macaroni*. The machine forms hollow or filled *cylindrical* sticks of candy or pastry [See p. 1, lines 45-54, incl. of Holmes patent specification]. This Holmes machine cannot produce ravioli, because it has no square or other suitably shaped molds, to form

pockets in sheets of dough, to receive ravioli stuffing, nor does said machine have any means for *forming and cutting marginal flanges of substantial width* around stuffing pockets, or any means for *firmly compressing together such flanges*, formed by the two sheets of dough compressed and cut between forming and cutting rollers, *to close such pockets and seal the stuffing effectively in such pockets.*

The Holmes machine has two pairs of rollers, e-h and e-h, or *four rollers* altogether for forming hollow or solid *sticks of pastry or candy*. The patented machine of the appellee, Barili, has only *two* co-acting rollers, 11 and 12, for forming, cutting and sealing *square-shaped ravioli* and the like. The Holmes machine has no means for cutting its products into square shape nor any means for sealing stuffing in a square-shaped pastry product such as ravioli. There being no marginal flanges along the *thin meeting edges* of the two semi-tubes of dough formed by the Holmes machine, said *thin meeting edges* of the tubular product could not be stuck and sealed together strongly enough to prevent the same from bursting apart under pressure of the stuffing in the tubular dough shell, which stuffing is *forcibly* pressed into said shell by the plunger *j* in the reservoir *i* containing the stuffing [See Fig. 1 of drawing and p. 2, lines 89-102 of the specification of Holmes patent].

The statement in the brief for Defendant-Appellants, page 8, that in the Holmes patent there is also found *wide marginal flanges* between the annular molds or grooves of rollers, *e, e*, which also unite and seal the paste sheets, is a gross misstatement. One glance at the drawings of the Holmes patent will clearly show that the

*annular ribs* between the annular grooves of the rollers *c* are definitely *very thin*. Moreover, Figs. 5 and 7 and Fig. 14 of the Holmes patent shows that the tubular or cylindrical product is formed *entirely within the annular grooves* of the rollers 2, and that there are *no marginal flanges* formed on the meeting edges of the product between the annular ribs of the opposing rollers *e*, as in the patent in suit.

The Holmes patent is nothing more than a paper patent. There is no evidence that the machine covered by the Holmes patent was ever successful in operation, or that its product was ever produced and sold on the market.

The statement on page 6 of defendants-appellants' brief, that the Holmes rollers *c* may be used independently of the roller 2 is irrelevant, because such use of said rollers forms *solid sticks*, while *ravioli* formed by the patented machine in suit is *not solid*, but has a *pocket containing stuffing* [See p. 3, lines 99-102, Holmes patent].

The Holmes machine could not perform the operations or accomplish the *new and useful results* of the Barili patented machine in suit, such as *forming square pockets* between two sheets of dough, *filling said pockets* with stuffing, *cutting the dough sheets into squares within which squares the pockets and stuffing therein are located*, forming *marginal flanges of substantial width around said pockets*, and finally *compressing said flanges* of the opposed cut sheets of dough together and effectively *scaling the stuffing in the pockets by said compressed flanges*, whereby *ravioli* is produced. The machine of the Barili patent in suit comprises a *new combination of elements*, which perform the *new functions* and operations, and ac-

*comply with the new and useful results*, as above described, and is a patentable invention marking a substantial advance in the art.

*Loom Company v. Higgins*, 105 U. S. 580 (591).

“A *combination* is a union of elements which may be partly old and partly new, a wholly old or wholly new. But whether new or old, the *combination* is a means—an *invention*—distinct from them” (the elements).

*Leads & Catlin v. Victor Talking Machine Co.*, 213 U. S. 318, quoted in *Diamond Rubber Co. v. Consol. Tire Co.*, 220 U. S. 428.

“the law looks not at the elements as factors of an invented combination as a subject for a patent, but only to the *combination* itself as a *unit* distinct from its parts.”

*Yesbera v. Hardesty Mfg. Co.*, 166 Fed. 120, at p. 125 (C. C. A. 6).

The Evans patent No. 1,094,320 is for a machine for the manufacture of feeding cakes for animals. The substance to be *compressed*—*meal or a mixture*—is introduced in bulk between the adjacent surfaces of the drums *x* and *y*, and said substance is *compressed* into square *cakes* by said drums between the laterally arranged teeth or projections *c* on the drum *x*, and the circumferentially arranged ribs or projections *d* on the drum *y*. The projections *c* and *d* are not knives or cutters, like the cutters 13, 14, 15 and 16 of the Barili patent in suit, because said projections are beveled to a considerable degree to perform their function of *wedging* and compressing therebetween the loose meal or mixture into the form



of *cakes*, and *not to cut* said loose material. The Evans machine does not handle *two thin sheets* of paste or dough, and has no means for introducing a filling between any such sheets to produce ravioli. Moreover, there are *no wide marginal* surfaces on either of the drums *x* and *y*, or cutters coacting with such surfaces for forming and cutting wide marginal flanges from sheets of dough, and compressing such flanges together to seal stuffing in ravioli. The Evans patented machine accordingly cannot perform the functions or accomplish the new results of the Barili patent in suit, and consequently the Evans patent is no anticipation of the Barili patent.

It is most significant that *claim 4* of the patent in suit, which claim the District Court held to be infringed by the defendants, was not rejected by the Patent Office on either the Holmes or the Evans patent, or any other prior art, but *was allowed without a single citation of prior art* against it. Claim 4 was amended upon the suggestion of the Patent Office Examiner for the sole purpose of eliminating what the Examiner considered vagueness, the Examiner stating that the claim otherwise "would no doubt be allowable," and it was allowed when amended to avoid the Examiner's so-called objection of vagueness [Tr. pp. 179-182 and 185; see also Deft. Ex. C, File Wrapper and Contents of Patent in suit, No. 1,844,142, pp. 36, 38, 40, 42 and 43]. Said amendment to claim 4 will be further considered hereinafter.

Since neither the Holmes nor the Evans patent, nor any other prior art, was cited by the Patent Office Examiner against claim 4 of the patent in suit, the attempt of counsel for appellants to set up said prior patents against said claim, and even without the testimony of a

patent expert, to invalidate said claim, against the strong presumption of validity of the patent in suit and particularly claim 4 thereof, in view of the record, is without merit and unworthy of serious consideration by this Honorable Court.

The Tommasini patent, No. 1,236,998 [Def't. Ex. G for Identification, Tr. p. 115] was not set up in the Answer of defendants [Tr. p. 6], to invalidate the patent in suit, but was offered only as prior art. The machine disclosed in this patent could not produce the standard *square-shaped* ravioli, because it handles and operates only *one* sheet of dough (indicated 1) at a time, from which sheet the ravioli envelope blanks (Fig. 1) are punched out in *circular* form, and said blanks are bent and folded upon themselves with stuffing forced therein, in the form roughly of a *half-moon*' [Fig 3, Tr. p. 115]. The *principle* of this Tommasini machine is quite different from that of the Barili patent in suit. In the Tommasini machine the *single* sheet of paste or dough 1 is fed *intermittently* and the forming rollers or cylinders 43-43 (Figs. 8-12) are correspondingly *rotated and produce ravioli intermittently*. In the *Barili* patented machine in suit the *two* sheets of dough 9 and 10 are advanced *continuously* and the two forming and cutting rollers 11 and 12 are *rotated and produce ravioli continuously*.

On page 1, lines 63-69, of the specification of the Tommasini patent, it is stated: "Through the intermediary of the toothed wheel 12 the pawl 8 produces the advance of the sheet of paste 1 *step-by-step*." On page 2 of said patent, included between lines 49-103, it is stated: "The severing member 22 is . . . provided with a lower flange 40, having an *arched cutting periph-*

ery 41 which is preferably indented as shown diagrammatically in Figs. 7 and 9, so as to sever and form the indented periphery on the *circular* piece of paste (Fig. 1) and thereafter *turn it back* as shown in Figs. 8 and 9.” . . . “It is necessary that the cylinders 43, 43 should not commence to carry the ravioli with them before the latter has received the stuffing and *it is also necessary that the stuffing should be fed to the ravioli while it is stationary.*” . . . “The plain and toothed portions of the wheels 50, 51 are of such dimensions that when the *feed of the sheet of paste ceases, the cylinder 43* for effecting the folding and closing operations *also stop* . . . During this *interval* the cutting of the pieces of paste and the deposit of the stuffing thereon takes place.”

From the foregoing it will be apparent that in the Tommasini machine the single sheet of paste (dough) is advanced *intermittently step-by-step*; that a *separate and additional severing member 22* is required to *sever the circular blanks* for forming a *half-moon shaped* ravioli, which *is not the standard square-ravioli*, produced by the Barili patented machine in suit; that the *intermittent* operation of the Tommasini machine to permit the stuffing to be fed into each ravioli envelope *while the machine is stopped* slows down the operation of the machine materially and thereby greatly reduces the productive capacity of the machine, in contrast to the *continuous operation* of the Barili patented machine in suit.

The stuffing in the Tommasini machine is supplied to the ravioli dough envelope 24 (Figs. 1, 8 and 9) by a *movable hopper 18*, which is moved down and up each time the stuffing is discharged therefrom into a ravioli dough envelope 24. In the Barili machine the hopper is

*stationary* and said movement of the Tommasini hopper is eliminated, thus simplifying and contributing to the speed, efficiency, and capacity of the Barili machine.

In the Tommassini machine the rollers or cylinders 43 have to rotate *a complete revolution to produce a single ravioli* on each pair of indentations 44, forming a mold on said rollers, while in the Barili machine there are *six molds*, and there can be a greater number of *molds* around the roller 11, in *each annular row of molds*, whereby *six, or a greater number, of ravioli may be produced by the Barili machine upon each revolution of said roller 11, for each ravioli produced by the Tammasini machine.* Moreover, the rollers 11 and 12 of the Barili machine are rotated *continuously* and produce ravioli *continuously*, while the rollers or cylinders 43 of the Tommasini machine are rotated *intermittently and have to stop each time a ravioli is produced* by the descent of the punch member 22 and piston 21, respectively, to cut the sheet of dough 1 into a circular blank 24 (Fig. 1), and to force the stuffing from the hopper 18 into said blank resting upon the indentations 44 on the rollers or cylinders 43. The sheet of dough 1 in the Tommasini machine is *punched full of holes* to form the ravioli blanks 24, as the dough sheet passes from the rollers or cylinders 43 over the roller 14 at the right end of the machine (Fig. 4), and *said sheet with the holes punched therein is either waste dough*, or if it is picked up and kneaded and formed into another sheet to be run through the machine again, this is a *hand operation* and makes the machine only *semi-automatic* and not a complete automatic and continuous operating machine in handling the dough and making ravioli. *The Tommasini machine also is not automatic*

because it has no means for taking a batch of dough and forming it into the sheet 1 and calibrating the sheet from which the ravioli blank 24 is punched by the punch member 22. The dough is evidently formed into the sheet 1 by another independent machine or rolled out by a *hand operated roller* on a flat surface and then placed by *hand* onto the machine. The Barili machine takes two batches of dough 1 and 2 (Barili patent) and *automatically rolls and calibrates the same into the sheets 9 and 10 of proper thickness* between the rollers 5 and 6, and the rollers 7 and 8, respectively, and feeds said sheets between the forming and cutting rollers 11 and 12 for enclosing the stuffing between said sheets and cutting the sheets into square ravioli and *sealing* the ravioli with *wide marginal flanges*. The Tommasini machine is evidently the machine which Mr. Barili had in mind when he testified [Tr. pp. 52 and 53], as follows:

*“it was an entirely different construction than the system I used. I invented my machine after that. The way my machine work, it reduces the sheet, roughly sized, reduces the sheet to proper thickness, and fits them, forms them, and cut them all automatically without any hand operation.*

Q. Is your machine *entirely automatic* after placing the dough and the filling into the machine? A. Yes.

Q. Do you know whether that machine in Italy was ever used in the United States? Did you ever see one in this country? A. Yes.

\* \* \* \* \*

Q. Was it automatic? A. Well, not entirely, because the sheet—instead of using two sheets, you use one, and that had to be of proper thickness, and

it made individual ravioli, and it worked in the system of a *punch press*, and not to lay the dough on. It was of the other—one layer only and fold over.

Q. Was that a different principle of operation?

A. Yes, entirely different.”

In the Barili machine there is *no waste* of dough because *all of the dough of the sheets 9 and 10 goes into the ravioli in one operation* and no surplus dough or scrap dough with holes cut in it goes out of the machine, as in the operation of the Tommasini machine.

There is no evidence that the Tommasini machine ever went into general use in this country, in view of its *lack of complete automatic operation*, its slowness of operation, in view of its *step-by-step, stop-and-go intermittent operation*, and its *necessarily small capacity and output*. The Tommasini machine is entirely inadequate to meet the demand of large packing plants. If it was ever used to any extent in this country and if any other ravioli machine has been so used, *such use has been supplanted by the use of the appellee's (Barili) machine*, as shown by its general use in the large packing plants, such as Riviera Packing Co., Inc., Superba Packing Co., Ltd., and Marlo Packing Corporation [Tr. pp. 53-85 and 88-105]. It is significant that the Tommasini patent is not cited in the Barili patent application [see File Wrapper, Deft. Ex. C].

If there is any doubt as to the novelty, patentability and validity of the Barili patent in suit, the *outstanding commercial success* of the Barili machine, as shown by

the evidence, should resolve such doubt in favor of the Barili patent.

“In fact it has been announced as a rule of law of the Ninth Circuit that it is proper to charge a jury that the fact that a device has gone into general use and has supplanted other devices used for a similar purpose is sufficient evidence of invention in the absence of evidence to show that the success was due to any other cause than that of the merits of the device.” (Walker on Patents, Deller’s Ed.), Sec. 44, pp. 239-240.)

*Sherman Clay & Co. v. Searchlight Horn Co.*, 214 Fed. Rep. 86 (1914) (C. C. A., 9th Circuit).

The Tommasini machine has no mechanical *automatic* means for returning the *punched surplus sheet of dough* to an independent mechanism for working over said surplus sheet, after the ravioli blanks have been punched from the sheet and the surplus punched sheet is discharged from the machine over the roller 14 at the right end of the machine (Fig. 4).

It takes *two men* to operate the Tommasini machine—one man to place the sheet of dough on one end of the machine (which sheet is first rolled on another mechanism) and another man to gather up the sheet of dough from the other end of the machine, after the ravioli blanks are punched therefrom, and carry said punched sheet of dough to another mechanism which first rolls the dough into sheets before it is placed on the Tommasini machine. The appellee’s machine requires only *one man* to operate it, because no surplus dough comes off the appellee’s machine to require another man to gather it up for again rolling it and using it over in the machine.

Appellants' attorney, on page 16 of his brief, quotes from the File History, page 37 [Tr. p. 174] of the appellee's patent in an attempt to show that the Tommasini machine is a prior automatic ravioli producing machine, but the *quotation does not state that said machine is automatic*. The statement quoted was made by the appellee's patent solicitor in an amendment as follows: "Applicant is not the first *to make a ravioli machine*." Nevertheless, the appellee denies that the Tommasini machine is a practical *automatic* ravioli producing machine, and reiterates that his patented machine is the *first practical and successful automatic continuously-operated ravioli producing machine*. Appellants' attorney left out an important part of the paragraph containing his quotation, which part supports the appellee's analysis of the Tommasini machine, as follows:

"Please note that Tommasini, in addition to a force feed, uses a pounder (Fig. 15), having experienced the difficulty of feeding flour paste. But *applicant is gradually replacing Tommasini, because it requires so much time and labor to operate and clean his device, that ravioli may be made cheaper by hand rollers*" [Tr. p. 174].

If ravioli may be made cheaper by hand rollers than by the Tommasini machine, said machine is certainly not a practical and successful ravioli producing machine. The statement that the machine of the applicant (appellee) is gradually replacing the Tommasini machine, because of the shortcomings of the latter machine, is evidence of the commercial success of the appellee's machine, and the patentability of the appellee's invention and validity of the appellee's patent, in view of such success.



Commercial success resulting from the merits of a machine like the appellee's machine is a deciding factor in determining the patentability of an invention, according to the Circuit Court of Appeals for this Ninth Circuit and the United States Supreme Court.

*Sherman Clay & Co. v. Searchlight Horn Co.*, 214 Fed. Rep. 86 (C. C. A., 9th Circuit, 1914);

*Krementz v. S. Cottle Co.*, 148 U. S. 558.

Considering further the statement of the appellee's solicitor, on page 37 [Tr. p. 174] of the File Wrapper of the plaintiff's patent, concerning the Tommasini machine, it is rather significant that after being informed of said machine, the Examiner in the Patent Office was not impressed with said machine, as clearly shown by the fact that he never cited the Tommasini patent as an anticipation of the appellee's (Barili) invention. This fact only emphasizes the lack of similarity of the Tommasini machine to the appellee's machine, and the fact that appellants' attorney has unduly magnified the position of the Tommasini machine in the state of the art out of all proportion to its real status therein. *No claim of the appellee's patent was rejected or limited by the Tommasini patent*, and such action of the Patent Office applies particularly to claim 4 of appellee's patent in suit [Tr. pp. 179-182].

If the Tommasini machine were an automatic machine containing the elements of the invention of the appellee's patent, it is truly significant that the defendant Bianchi did not copy the Tommasini machine, but copied appellee's machine and infringed appellee's patent, as shown by the fact that Bianchi took the appellee's machine from the Superba Packing Company to his shop and had all of its

parts here and there on the floor with numbers painted on them in order to copy appellee's machine to build the first Bianchi infringing machine for the Superba Packing Company, which was in operation when the appellee called at the appellant Bianchi's shop and saw his said dismantled machine on the floor [Tr. pp. 103-104]. Bianchi certainly would not have rejected the Tommasini machine and copied appellee's machine if the appellee's machine had not had outstanding merits as an automatic ravioli machine.

“In each of the many arts many patents have been granted on a corresponding number of new combinations of old parts for performing precisely the same function. The earlier of those combinations may be useful; *but not useful enough because not rapid enough*. To deny the quality of invention to all the later, different and far superior combinations for doing the same things would be unreasonable and unjust and plainly contrary to section 4886 of the Revised Statutes.”

Walker on Patents (Deller's Ed.), Vol. 1, Sec. 41, p. 216.

Appellee's patent does not have to be a pioneer or primary patent to be entitled to the doctrine of equivalents, and particularly to include such equivalent machines as the Bianchi infringing machines, which imitate so closely the appellee's patented machine, as claimed in claim 4 of the appellee's patent in suit.

Walker on Patents (Deller's Ed.), Vol. 2, Sec. 247, p. 1212.

It certainly does not call for a liberal construction of the appellee's patent to read claim 4 on the Bianchi ma-

chine [Exhibit B] in which the rollers are identical to the appellee's rollers, *except for the mere transfer of the axial cutters from one roller to the other*, without changing the function or operation of the appellant Bianchi's machine in cutting the ravioli, according to Bianchi's own testimony [Tr. pp. 92, 93, 95-100].

*The ruling of the Circuit Court of Appeals of this Ninth Circuit in The Portland Telegram v. New England Fiber Blanket Co.*, 38 F. (2d) 780 (C. C. A. 9) (1930) *is controlling of the case at bar, regardless of whether the appellee's patent is a primary or a secondary patent.* The ruling in said case is stated in Walker on Patents (Deller's Ed.), Vol. 2, Sec. 247, page 1212, as follows:

“Where an invention undoubtedly marks a substantial advance in the art, the patent is to be given a reasonable liberal construction so as to secure to inventors the reward to which they are entitled.”

The appellee's machine certainly marked a substantial advance in the art of manufacturing ravioli over the Tommasini machine, which was the only machine of which there was any evidence of use. While the Tommasini machine makes *one ravioli upon a revolution of the rollers*, appellee's machine makes *six ravioli*. But in the Tommasini machine the rollers stop during each revolution to permit the dough to be punched and the stuffing to be pressed into the punched out dough to make a ravioli. *The Tommasini rollers are at rest at least half the time the machine is in operation.* The rollers of appellee's machine rotate *continuously*, and for each *ten* revolutions per minute of the appellee's rollers, *sixty* raviolis in each annular row of *six* molds are made by appellee's machine,

while only *five* raviolis in *one* mold can be made with the Tommasini machine, when its rollers are intermittently rotated at the same speed.

In said case, *The Portland Telegram v. New England Fiber Blanket Co.*, *supra*, the change in the defendants' infringing device was greater than the slight change in the defendants' (appellants) rollers in the present case, yet the Circuit Court of Appeals held that the defendant's device infringed the plaintiff's patent. In said case the patent specified a *single* piece or sheet and the defendant used *more than one piece or sheet*, and thereby *added one or more elements* to the defendant's structure, while the defendants (appellants) in the present case merely *transposed or reversed* one of the cutters of the rollers, but *did not add another element* to the machine. The Court of Appeals in said case held as follows:

"Appellant's position is that under the patent appellee can claim a monopoly for such a make-ready only when it is in a *single* piece or sheet. *With this view we are unable to agree.* As already suggested, we think by *their reference in the patent to a single sheet or strip the patentees intended only to differentiate their invention from the make-ready* then familiar in the art consisting of two pieces or units differing both in character and in function. *Their patent, therefore, is not to be so restricted as to exclude from its coverage the use of a plurality of sheets of the same character and performing identically the same function, as a single sheet of equal bulk.* Their invention undoubtedly marked a substantial advance in the art, and their patent is to be given a reasonably liberal construction, so as to se-

cure to them the reward to which they are entitled. See *Eibel Co. v. Paper Co.*, 261 U. S. 45, 43 S. Ct. 322, 67 L. Ed. 523.”

It thus appears that the Court of Appeals in the above case rationalized the patent in suit by construing the claims thereof according to the *spirit and intent* of the language of the patent, rather than according to the *letter* of the language thereof, and held the patent valid and infringed by the defendant, despite the technical difference between the patented device and the infringing device.

“The Court should proceed in a liberal spirit, so as to sustain the patent and the construction claimed by the patentee himself, if this can be done consistently with the language which he has employed. In case of doubt, where the claim is fairly susceptible of two constructions, that one will be adopted which will preserve to the patentee his actual invention. The object of the patent law is to secure to inventors, a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation.”

Walker on Patents (Deller's Ed.), Vol. 2, Sec. 241, p. 1206;

*Klein v. Russel*, 19 Wallace, 433 (1873);

*McClain v. Orimayer*, 141 U. S. 425 (1891);

*Topliff v. Topliff*, 145 U. S. 171 (1892).

The print, Defendants' Exhibit A for identification, of alleged prior automatic ravioli machines, and particularly the machine entitled “Raviolara”, which was offered only as prior art [Tr. p. 82], is *not prior art*. *There is no*

*date of publication* on said print, and Mr. Barili testified than an application for patent for the Raviolara machine shown in said print was filed in Italy, and was rejected in view of a prior Italian patent which Mr. Barili secured for his machine [Tr. pp. 80-82]. Mr. Barili further testified that he was in correspondence with Mr. Mario Eccher, the name on that circular and the man who issued said circular [Deft. Ex. A for identification] a few years before he got his patent; that he sent some photographs of his machine to said Mario Eccher for the purpose of selling his machines in Italy; that he came to an understanding with said Mario Eccher for payment by him to Mr. Barili for the use of his machine under his Italian patent, which was already issued in Italy; that negotiations concerning Mr. Barili's Italian patent were suspended during the depression of 1932 or 1933; that in the meantime he received a letter from a party in Milan, Italy, desiring to negotiate for the use of Mr. Barili's Italian patent, which letter stated that somebody asked for the drawing of Mr. Barili's invention and somebody applied for a patent on said invention in Italy, which was rejected; and that later a patent was secured on Mr. Barili's invention in France a couple of years after the issuance of Mr. Barili's patent in Italy [Tr. pp. 85-87]. The illustration "Raviolara" on Defendants' Exhibit A for identification was no doubt reproduced from the photographs of Mr. Barili's machine, which he sent to Mario Eccher in Milan, Italy, the man whose name appears on the circular and who issued the circular, Defendants' Exhibit A for identification. Mr. Barili's testimony cancels out Mr. Bianchi's uncorroborated testimony concerning Defendants' Exhibit A for identification [Tr. pp. 80-82 and 85-87] and said exhibit is of no

probative value whatever, concerning the validity or scope of the patent in suit.

It will be noted that Defendants' Exhibit A for identification looks rather fresh for a paper circular picked up in Italy after the first World War in 1919 [Tr. p. 114].

The testimony of the appellant Bianchi concerning the "Raviolara" pamphlet is not corroborated and amounts to nothing more than a self-serving declaration of a party to this suit. Bianchi's uncorroborated testimony as to the date of the "Raviolara" pamphlet, which date is contradicted by appellee Barili [Tr. pp. 80-82; Deft. Ex. A for identification] fails to prove that said pamphlet is prior art, and is consequently incompetent, irrelevant and immaterial. *Bianchi did not describe the construction or operation* of the "Raviolara" machine with sufficient certainty to prove that it contained the vital elements of the appellee's patented invention that makes it an *automatic* machine. Parole testimony of the contents of printed pamphlets is generally inadmissible.

*McMahon v. Tyng*, 14 Allen (96 Mass.) 167, 168-171 (1867).

The Oleri patent, No. 1,479,925, January 8, 1924, is a single hand-operated device in the form of a rolling pin, which is rolled by hand over two sheets of dough with stuffing therebetween for forming ravioli. The patent, page 1, lines 83-87, states that "the material comprising the ravioli is first laid flatly upon a table (evidently by hand) after which the shaper and cutter is rolled (obviously by its handles 2) over the same, thereby forming, sealing and cutting the individual raviolis in one operation."

The Oleri device has *no automatic means* for bringing two sheets of dough into juxtaposition to receive a stuffing therebetween; it has *no automatic means* of introducing a stuffing between moving juxtaposed sheets of dough; and it has *no automatic means* for forming and cutting ravioli from the ravioli material. The Oleri device has *no wide marginal surfaces* for forming *wide marginal flanges for sealing* the stuffing in the ravioli around the edges thereof. The circumferential projections or ribs 3 and the longitudinal wooden strips 4 of the Oleri patented device are very narrow, and do not provide wide marginal surfaces for forming wide marginal sealing flanges around the ravioli, as provided on the rollers 11 and 12 of the appellee's patent. The Oleri device is only a kitchen utensil—a gadget.

In rolling the dough out flat into two sheets by a rolling pin for making ravioli with the Oleri device, *it is not possible to roll the sheets of dough with the rolling pin to a uniform thickness throughout*, and as the Oleri device is constructed with metal strip cutters 5 of *uniform* depth for cutting the dough, said cutters upon engaging the surface of the table determine a *uniform* thickness to which the two sheets of dough may be compressed between the wooden annular projections 3 and strips 4, and the surface of the table for compressing the marginal flanges of the ravioli uniformly together to seal the edges of the ravioli. Consequently, when the Oleri *single-roller* device is rolled over the two sheets of dough of varying thickness on a table with stuffing between the sheets, the



thinner portions of said sheets forming narrow marginal flanges of the ravioli will not be pressed firmly together like the thicker portions of the sheets, but will be left spaced apart and unsealed with stuffing between them, which unsealed flanges will spread open and permit the stuffing to drop out of the ravioli, and particularly during boiling and cooking of the ravioli for eating.

The above objection to the Oleri device is overcome by the machine of the Barili patent in suit with the use of the calibrating rollers 5 and 6, and 7 and 8, and the two forming and cutting rollers 11 and 12. The rollers 5 and 6, and 7 and 8 calibrate the sheets of dough 9 and 10, respectively, to the correct and a *uniform* thickness, while the forming and cutting rollers 11 and 12 may be adjusted and set at their point of *working contact* so that the two dough sheets 9 and 10, passing between said rollers 11 and 12, will be compressed uniformly and firmly together between said latter rollers, at the marginal portions 30, 34 and 32 of the molds 11<sup>a</sup> and 11<sup>b</sup> of roller 11, to form and *tightly seal* the marginal flanges of the ravioli, as shown in Figs. 2, 3 and 4 of the patent drawings; and as said marginal ravioli flanges of the two sheets of dough are compressed together between the rollers 11 and 12, any stuffing between said flanges will be squeezed upwardly from between said flanges back up into the bottom of the stuffing hopper 20 (see page 2, lines 5-14, of Barili patent in suit). Consequently, in the operation of the Barili machine, the marginal flanges of the ravioli cannot be left spread apart and unsealed with stuffing between said

flanges, as it would frequently happen in the use of the Oleri single hand-roller device when portions of the dough sheets are rolled too thin by a rolling pin.

The Oleri device is not an automatic ravioli machine suitable for factory mass production, like appellee's patented automatic stuffed pastry machine. The Oleri device does not have the important novel and distinctive elements of appellee's automatic machine; it cannot function like appellee's machine; and it cannot accomplish the new and superior results of appellee's machine. The Oleri patent was not even cited by the Patent Office against the Barili patent application, as appears from the Barili file wrapper, and it has no bearing on the Barili invention.

The brief of defendants-appellants, on page 13, contains the absurd assertion that the Patent Office Examiner entirely overlooked the Oleri patent, which shows molds with *viae* margins between the cutters and the molds. One glance at the Oleri patent will show that margins between the cutters and the molds are clearly and decidedly *very narrow*—so narrow that the margin flanges of any ravioli produced by the Oleri roller would not be sufficiently wide to form an effective seal when compressed, to prevent the marginal edges of the ravioli from coming apart and allowing the stuffing to drop out, and especially if the Oleri roller were used in a fast automatic machine like Barili's patented machine in suit, in which the sheets of dough are subjected to considerable strain by the rollers 11 and 12. It is inconceivable that the Patent Office Examiner overlooked the Oleri patent, and the pre-

sumption is that it did not. The Examiner no doubt did not cite the Oleri patent because in his expert judgment it does not disclose the invention of the Barili patent in suit, as hereinbefore particularly described and as described in the specification and claim 4 of the patent in suit. It will be noted that claim 4 of the patent in suit specifies the *molds 11<sup>a</sup>* and the *molds 11<sup>b</sup>* being *spaced apart* so as to provide a *wide margin* between the cutters and the molds, *means* for feeding *sheets* of flour paste or dough to the rollers, and a *detachable* open bottom *hopper* for *guiding* stuffing to the paste or dough sheets on the rollers. These novel elements and their functions are neither disclosed nor suggested in the Oleri patent.

Concerning the fact that the Oleri patent was not cited against claim 4 of the patent in suit, it should be noted that no other patent or prior art was cited against that particular claim [Tr. pp. 179-182 and 185]. Claim 4, original claim 31, was inserted in the application for the patent in suit near the end of the prosecution of the application and at a time, over three years from the filing date of said application, when the Patent Examiner was thoroughly familiar with the invention in suit and the prior art, and it is highly improbable that the Examiner could have overlooked the Oleri patent or any other patent in the art.

The case of *Hoc v. Goss*, 30 F. (2d) 271, 284, cited on page 14 of Appellants' Brief, is not in point because the Oleri patent does not disclose the novel elements of claim 4 of the patent in suit, as above pointed out. If

there were any doubt whether the Patent Examiner overlooked the Oleri patent, the patent in suit is entitled to the benefit of the doubt.

Walker on Patents, Deller's Ed., Vol. 1, Sec. 63,  
pp. 300-302;

*Wilson & Willard Mfg. Co. v. Bole*, 227 Fed. Rep.  
607 (9th Circuit);

*Bell Telephone Case v. American Telephone Co.,  
et al.*, 22 Fed. Rep. 209;

*Searchlight Horn Co. v. Victor Talking Machine  
Co.*, 261 Fed. Rep. 395 (9th Circuit).

The case of *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 284 U. S. 484, 486, cited on page 14 of Appellants' Brief, is not in point, because the machine covered by the patent in suit embodies a *new principle* and accomplishes a *new and useful result*, to-wit: produces ravioli *automatically and continuously without waste*, with two sheets of dough of *uniform thickness*, and with *wide marginal sealing flanges compressed together with uniform pressure into adhesive and effective sealing contact*. The *invention* of the patent in suit could not be constructed from the Holmes, Evans, Tommasini, Oleri or other prior patents. The applicable rule is stated in *Topliff v. Topliff and another*, 145 U. S. 156, 36 L. Ed. 658, as follows:

“It is not sufficient, in order to constitute an anticipation of a patented invention, that the device relied upon, might, by modification, be made to accomplish the function performed by that invention, if it were not designed by its maker, nor adapted, nor actually used for the performance of such function.”

### File Wrapper Amendments.

No significance should be attached to the fact that certain claims in the application for the patent in suit, as appears in the file wrapper, were rejected, as originally filed, and thereafter cancelled or amended or new claims inserted to avoid the prior art. This practice is typical of the prosecution of practically all patent applications in the Patent Office.

It is significant, however, that *claim 4, the only claim in issue in this appeal was not rejected on any prior art, and was amended at the suggestion of the Patent Office Examiner only to clarify the claim and to comply with the requirement of the Examiner [Tr. pp. 179-181], whereupon said claim [originally numbered 31, Tr. p. 179] was allowed by the Examiner as amended without narrowing its scope as originally filed [Tr. p. 182].* The prosecution of said claim was short and sweet, and unlimited by the prior art, or any action by the Patent Office or any other claim in the patent application.

“Where reference to history of patent in Patent Office discloses that in original application a claim was made and rejected, *but none of the claims involved in infringement suit was amended or narrowed by reason of such rejection, such claims should not be narrowed or restricted because of the action of the Patent Office.*”

Walker on Patents (Deller's Ed.), Supplement to Vol. II, Sec. 249, p. 110;

*France Mfg. Co. v. Jefferson Electric Co.*, 106 F. (2d) 605 (C. C. A. 6, 1939), c. d. 309 U. S. 657, 84 L. Ed. 1006 (1940).

“It may be remarked that courts generally have been disposed to give much consideration to the fact that an applicant for practical reasons of expediency is often compelled to unduly narrow his claims while the application is pending, and in such cases *lean as far as possible in the direction of liberality* where the limitations imposed by the Patent Office appear to have been unwarranted. It may be noted that the Court of Appeals of the Second Circuit *gives effect to limitations imposed by the Patent Office only in so far as an estoppel has been created*. Westinghouse Elec. Mfg. Co. v. Condit Elec. Mfg. Co., 194 Fed. 427, C. C. A. 2),” and other cases cited.

Walker on Patents (Deller’s Ed.), Vol. II, Sec. 249, p. 1218.

It may be noted in passing that claim 1 of the patent in suit was amended only to make it accurate, and such amendment broadened the claim, while claims 2, 3 and 5 were allowed as presented and without amendment [Tr. pp. 161, 163-164, 173, 176, 177 and 178].

There is *no prior art* that shows a forming and cutting roller with *wide margins* between the cutters and the molds, as specified in claim 4 of the patent in suit, whereby *wider marginal sealing flanges* are formed on the ravioli for effectively sealing the ravioli. Such *wide margins* on the forming and cutting roller 11 is a *novel element* of the invention of the patent in suit, and said element in claim 4 of the patent provides a *new combination* of elements which constitutes a patentable invention.

On pages 15 and 21 of the Brief for Defendants-Appellants, an attempt is made to misconstrue the meaning of the words “at the point of contact of the rollers,” which

words were inserted in claim 4 of the patent in suit by amendment *at the suggestion of the Patent Office Examiner*, who is an expert in the art and certainly should know the correct terminology of the art. Said amendment was not required in order to avoid any prior art, but only to clarify claim 4, which the Examiner otherwise considered to be vague. Appellants' attorney assumes that there is no point of contact between the rollers 11 and 12 of the patent in suit, but as a matter of fact *there is definitely a point of contact between said rollers*, when it is considered that the cutters 13 and 14 are constituent parts of roller 12 and contact the peripheral surfaces 30 and 34 of the roller 11, while the cutters 15 and 16 are constituent parts of roller 11 and contact the peripheral surface of the roller 12 at a point between said rollers on a line drawn through the centers of said rollers, as illustrated in Figs. 1 and 4 of the drawings of the Barili patent in suit. If any part of an object contacts any part of another object, *the objects contact each other* and, consequently, with the constituent cutters of each roller of the patent in suit in contact with the peripheral surfaces of the other roller, the rollers 11 and 12 of said patent unquestionably *contact each other*.

Even if the word "contact" were applied only to the cylindrical surface of the rollers 11 and 12, which surfaces are spaced slightly apart to permit the sheets of dough to pass and be compressed therebetween, such slight spacing would be included within the dictionary meaning of the word "contact" and the sense in which the word is used in the patent in suit. According to the leading dictionaries the meaning of the word "contact" is not restricted to an actual touching of two objects. The meaning of the word "contact" is determined by the

sense in which the word is used. A few dictionary definitions of the word "contact" will illustrate the elasticity of meaning of the word:

*The Oxford English Dictionary:*

"Contact: To come in contact with: come across, be brought into *practical* connection with. \* \* \*

1862 Lewis Astron. Ancients i.

§1.2. The *history of astronomy* has numerous *points of contact* with the general *history of mankind*."

*20th Century Dictionary:*

"Contact: To be in touch or juxtaposition with."

Note: *Juxtaposition* means a placing or being placed in *nearness* or contiguity, the state of being *side-by-side*.

*Webster's New International Dictionary:*

"Contact: Military—Proximity (to other troops of the same command or to the enemy) sufficiently close to permit of constant communication or observation. Medical—A person who has been exposed to a contagious disease."

The placing of the rollers 11 and 12 of the patent in suit with their cylindrical *surfaces* irrespective of *their cutters*, in slightly spaced relation, to permit the two sheets of dough to pass and be *compressed between said roller surfaces*, positions said rollers *side-by-side*, in *juxtaposition* and in *operative, working contact*, for producing ravioli, and said position of said rollers comes particularly within the definition of the word "contact" as defined above in the 20th Century Dictionary.



It is significant that the word "contact" is not listed or defined in the leading Knight's Mechanical Dictionary, which leaves a wide latitude of meaning of the word when used in mechanics, as it is used in the patent in suit, and particularly in claim 4 of the patent. The meaning of the word "contact" in claim 4 must necessarily be determined by the specification of the patent in suit, since the specification is the dictionary of the claims.

"Technical use of words is not necessary; an inventor has the right to use such words as seem to him to best describe his invention, and they will be so construed as to effectuate that result. A patentee is at liberty to select and supply his own dictionary."

Walker on Patents, Deller's Ed., Vol. 2, Sec. 163,  
p. 757;

*Wheeler Salvage Co. v. Rinelli et al.*, 205 Fed. Rep.  
717, 727;

*In re Christian*, 308 O. G. 231;

*Kennicott Co. v. Holt*, 230 Fed. Rep. 157.

The meaning of the word "contact" as it appears in claim 4 of the patent in suit is given in the patent on page 2, lines 4-7, as follows:

"The two rollers 11 and 12 are adjustably fixed *so close together* that the two sheets of paste are very firmly pressed together."

In such close relationship the rollers 11 and 12 are in mechanical *juxtaposition* and in operative "contact" for making ravioli; and such relationship of the rollers comes

within the dictionary definitions of the word “contact” as it appears in claim 4 of the patent in suit. The term “at the point of contact of the rollers” properly describes the relationship of the rollers in the light of the ruling of this Honorable Court in *Goodman v. Paul E. Hawkinson Co.*, 120 F. (2d) 167, p. 171 (C. C. A. 9, 1941), as follows:

“(5) Claim 6 does not indicate any *compression* of the tire except by the phrase ‘*permitting expansion* thereof against an annular matrix.’ The patent owner claims that this indefinite statement must be interpreted in the light of the patent *drawing and specifications*. This is in accord with our decision in *Shull Perforating Co., Inc., v. Paul Cavins*, 9 Cir., 44 F. (2d) 357, 364, where we said: ‘The patentee is entitled to have the claims of the patent construed with reference to the *drawings and specifications*. Where the means referred to in claims are clearly shown in the description of the patent, this description is sufficient to cover the means thus disclosed and its mechanical equivalent.’ Walker on Patents, 6th Ed., Vol. 1, p. 195, sec. 162a. \* \* \* *Wessel v. United States Mattress Mach. Co.*, 6 Cir., 139 F. 11, 15.”

*Schick Dry Shaver, Inc., v. Dictograph Products Co.*, 89 F. (2d) 643 (C. C. A. 2, 1937);

*Schick Dry Shaver, Inc., v. R. H. Macey & Co., Inc.*, 111 F. (2d) 1018 (C. C. A. 2, 1940).

The amendment of claim 4 by inserting the words “at the point of contact of the rollers” did not change the

substantial meaning of the claim as it stood before amendment, and, consequently, said amendment does not invalidate said claim.

“Changes in language not changing the substantial meaning as it stood before amendment and even changes of meaning narrowing the scope of the invention described, do not infringe the statute.”

*Wire Tire Machinery Co. et al. v. Paper Box Corp., Ltd., et al.*, 102 F. (2d) 543 at p. 560, 41 U. S. P. Q. 66.

The ruling of the lower court concerning the word “contact” includes the following statement:

“Despite defendants’ contention that the word contact means ‘touch,’ the Court is not persuaded to accept such a definition, nor to find a distinction in the two machines based on a refined dictionary definition which has no place in the terminology of scientific text books.”

It is submitted that the above ruling of the lower court is sound and should not be disturbed by this Honorable Court.

### Validity.

The lower court has held the Barili patent in suit valid, in its Conclusion of Law 3 and in its Final Judgment, paragraph 2 [Tr. pp. 25 and 27], and there is nothing in the prior art that would justify a reversal of this holding of the lower court.

### Infringement.

Infringement of claim 4 of the Barili patent in suit by both defendants-appellants, Achille Bianchi and Marlo Packing Corporation, is charged by the plaintiff-appellee, Arthur E. H. Barili, and the lower Court has upheld said charge of infringement in its Findings of Fact 1 and 3 [Tr. p. 24], in its Conclusions of Law 4 and 5 [Tr. p. 25], and in its Final Judgment, paragraphs 3 and 4 [Tr. p. 28].

The elements of claim 4 of the patent in suit are contained in the ravioli machine manufactured and sold by the defendant-appellant, Bianchi, and used by the defendant-appellant, Marlo Packing Corporation, which elements are described in the Answer to Interrogatory 7 and shown in the print attached to the interrogatories of defendants Achille Bianchi and the Marlo Packing Corporation and answers thereto.

Said interrogatories and answers are marked Plaintiff's Exhibit 2 for Identification [Tr. pp. 8-13 and 51]. The answer to interrogatory 7, and the print attached to the answers to the interrogatories, describe and show the intergearing rollers 11 and 12 with indented molds 11<sup>a</sup> and 11<sup>b</sup>, and 12<sup>a</sup> and 12<sup>b</sup>, annular cutters 13 and 14, and axial cutters 15 and 16, wide peripheral margins 11<sup>c</sup> and 12<sup>c</sup> between the molds and the cutters 13-16, between which margins and the opposite roller the paste sheets become firmly compressed together, means for feeding sheets of paste to the rollers 11 and 12, which means are indicated as the rollers 5 and 6, and 7 and 8, tables 3 and 4, chain 39, sprockets 39<sup>a</sup> and 39<sup>b</sup>, chain 44 and sprockets 44<sup>a</sup> and 44<sup>b</sup>, and a detachable open-bottom hopper 20 for guiding the stuffing to the paste sheets on the rollers 11 and 12. While molds are shown in *both* rollers in the interrogatory

print, this arrangement is an obvious equivalent of the molds in only *one* roller, as included in claim 4 of the patent in suit, because the result produced by *two coating shallow molds* and the result produced by *one deeper mold* is the same in producing ravioli. Both forms of molds are included in the patent in suit, because Figs. 1, 4 and 5 show the single deep molds in one roller 11, while Fig. 6 shows the two coating shallow molds in both rollers 11 and 12; and the construction of the two coating molds in the two rollers is described in the specification, page 3, lines 26-27, of the patent in suit.

The interrogatories of defendants and answers thereto were marked Plaintiff's Exhibit 2 for Identification, in view of the groundless objection and self-serving and irregular *testimony of counsel* for defendants; and it was error of the trial court in not formally admitting said interrogatories and answers in evidence, because said interrogatory answers and print are in fact and in law in accordance with the constructions manufactured and sold by the defendant Bianchi and used by the defendant Marlo Packing Corporation. Defendants' attorney asked for the interrogatory print and he got what he asked for, and is bound by it, and in the absence of proof to the contrary, the structure of the rollers shown in said print is proof by a preponderance of evidence that the structure of the rollers of the Marlo machine, built and sold by the defendant Bianchi, Defendants' Exhibit B, is the mechanical equivalent of the structure of the rollers shown in said print. Consequently, the Marlo machine, which contains all of the other elements of claim 4, is an infringement of said claim.

Defendant-appellant, Bianchi, *did not deny* that he made his forming and cutting rollers exactly like the rollers 11

and 12 as specified in claim 4 of the Barili patent in suit, that is to say, with molds and axial cutters on one roller and annular cutters on the other roller. Bianchi testified as follows:

“A. Yes, I made some rollers with the pocket, the margin, and the cutters all in one roller, which we have patent. I made it for the lady Mr. Trabucco has.

Q. Did you ever make any with the *annular cutters on one roller*? A. Not that I remember, *which is not necessary*.

Q. *The axial cutters on the other roller*? A. I can't recall. *It doesn't matter a bit*. You can put them any way you want to.

Q. *Did you ever do it that way*? A. *I can't recall.* [Tr. p. 99.]

\* \* \* \* \*

“Q. *Will you swear you did not make them that way*? A. *No, I won't*.

Q. You won't swear to that. *Will you swear you did not make rollers with longitudinal cutters on the roller that had the pockets in that machine for the Riviera Packing Company*? A. *I won't swear to that either*.

Q. *You won't swear you did not*? A. *No*. Why should I swear when I am not positive? I am not that kind.” [Tr. p. 100.]

With the positive testimony of the plaintiff-appellee, Barili [Tr. pp. 69-70 and 83-84], the testimony of the witness Cortopassi [Tr. pp. 88-89] and the testimony of the witness Gierth [Tr. pp. 66-67], concerning the construction of the rollers of the Marlo machine, Defendants' Exhibit B, and defendant-appellant Bianchi's failure to

deny that he made such roller construction, the plaintiff-appellee proved by a preponderance of evidence, infringement of claim 4 of the patent in suit by the defendant-appellant, Bianchi, in building and selling the Marlo machine to the defendant-appellant, Marlo Packing Corporation.

If there could be any doubt as to the proof of infringement of claim 4 of the patent in suit by the interrogatories of the defendant and answers thereto, including the interrogatory print, such doubt is resolved conclusively in favor of the plaintiff-appellee, Barili, by the *Defendants' Exhibit B* [Tr. p. 107], which shows the Marlo ravioli machine built by the defendant-appellant, Bianchi, and sold by him to the defendant-appellant, Marlo Packing Corporation, which used said machine.

The defendant-appellant, Bianchi, testified that there must be cutters to separate the ravioli, and that it is immaterial how or where the cutters are placed on the rollers, because they will work just the same [Tr. pp. 101, 99 and 97]. If it is immaterial where the cutters are placed on the rollers, the transposition of the axial cutters 15 and 16 on the mold roller 11 of the patent in suit (Fig. 4) to the other roller 12 with the annular cutters, as shown in the photographs of the Marlo machine [Defendants' Exhibit B: Tr. pp. 98 and 107], would amount to nothing more than a mechanical equivalent of the rollers shown, described and claimed in claim 4 of the patent in suit, and such equivalent constitutes an infringement of said claim 4 of the patent in suit.

The Marlo machine [Defendants' Exhibit B] is a Chinese copy of the plaintiff's ravioli machine, as covered by claim 4 of the patent in suit, with the exception of the transposition of the *axial* cutters from the roller 11 with

molds or pockets to the other roller 12 on which the *annular* cutters are located. Such transposition of the axial cutters is a mechanical equivalent of the novel combination of elements of claim 4 of the patent in suit and is an infringement of said claim jointly and severally by the defendants, Achille Bianchi and Marlo Packing Corporation.

“Changing the relative position or reversal of the parts of a machine or manufacture does not avert infringement, where the parts transposed perform the same respective functions after the change as before. (Adams v. Mfg. Co., 3 Bann. & Ard. 1, Fed. Cas. No. 56 (1877); Devlin v. Paynter, 64 Fed. 398 (1844)),” and other cases cited.

Walker on Patents (Deller’s Ed.), Vol. 3, Sec. 463, pp. 1699-1700.

“There are two tests of equivalency; (a) identity of function; (b) substantial identity of way in performing that function.”

Walker on Patents (Deller’s Ed.), Sec. 466, p. 1703.

The Marlo machine, as shown in Defendants’ Exhibit B [Tr. pp. 97-98 and 107], meets those tests of equivalency perfectly, because the Marlo machine performs the identical function of the appellee Barili’s machine in making ravioli, and performs that function in substantially the identical way as the Barili machine with forming-and-cutting rollers that are identical to the Barili rollers, with the exception of the transposition of the axial cutters from



one roller to the other in the Marlo infringing machine, which transposition does not change the operation of the machine [Tr. pp. 97, 99].

“No substitution of an equivalent for any ingredient of a combination covered by any claim of a patent can avert the charge of infringement of that claim (O’Reiley v. Morse, 15 How. (56 U. S. 61, 62 (1853)) (and other cases cited), whether or not the equivalent is mentioned in the patent. Treibacher Chemisch Works Co. v. Rossler & Hasslacher Chemical Co., 219 Fed. 210 (1914).”

Walker on Patents (Deller’s Ed.), Vol. 3, Sec. 464, pp. 1700-1701.

An important test, in determining the question of infringement of a patent, is *interchangeability* or non-interchangeability of *parts* of a patented machine and the parts of the alleged infringing machine. *The forming-and-cutting rollers of the appellants’ ravioli machine* being substantially identical to the corresponding rollers of the appellee’s machine, the appellants’ rollers, *if placed in the appellee’s machine, would operate the same and perform identically* the same function as the appellee’s rollers in making ravioli.

Walker on Patents (Deller’s Ed.), Sec. 470, p. 1708;

*Miller v. Eagle*, 151 U. S. 186, 38 L. Ed. 121, 14 S. Ct. 310.

In the Brief for Defendants-Appellants, page 19, it is incorrectly asserted that claim 4 of the patent in suit is further limited to a structure wherein the rollers are in contact with one another, while in defendants’ machine the rollers are separated appreciably from one another.

Claim 4 of the patent in suit specifies the other roller being made with annular peripheral cutters *adapted to be positioned* between the molds of the first roller *at the point of contact of the rollers*. The phrase “*adapted to be positioned*” in claim 4 means that the *rollers are adjustable* toward or away from each other at the *point of contact of the annular cutters 13 and 14 of roller 12 with the surface of roller 11* between the molds, as shown in Figs. 1 and 4 of the drawings of the patent in suit. Such adjustment is supported by the specification of the patent in suit, page 2, lines 4-7, which states:

“The two rollers 11 and 12 are *adjustably* fixed so close together that the two sheets of paste are very firmly pressed together.”

The rollers of the defendants-appellants’ machine, Defents’ Exhibit B, are likewise *adjustable* toward or away from each other *at the point of contact* of the cutters of one roller with the surface of the other roller. The witness Cortopassi testified [Tr. p. 89], concerning the rollers of the defendants-appellants’ machine, Defendants’ Exhibit B, as follows:

“Q. One of the rollers had pockets in it, had square molds in it, depressions? A. Yes.

Q. One roller? A. One is support. Another to adjust, like go back.

Q. One roller is *adjustable*? A. *One is adjustable.*”

Adjustability of the rollers of the Bianchi-Marlo machine is illustrated in Defendants’ Exhibit B, photograph E, but the adjustment shown in said photograph shows the forming and cutting rollers *adjusted out of their normal operative position* whereby the rollers are “*separated*

*appreciably from one another,*” to support said incorrect statement appearing on page 19, lines 11 and 12, of the Brief for Defendants-Appellants, in an attempt to set up an *artificial difference* between the positioning and operation of the rollers of the machines of the opposing parties to this suit. The adjustment of the rollers illustrated in Photograph E shows a space between the rollers too wide for the rollers to coact in order to make ravioli. The rollers in the defendants-appellants’ machine, as well as in the plaintiff-appellee’s machine, *must be adjusted very close together with the cutters on one roller in contact with the surface of the other roller*, so that the wide marginal flanges of the two thin sheets of dough of the ravioli will be compressed firmly together by the rollers, to seal the ravioli, and the cutters will cut the square-shape ravioli from the two sheets of dough passing between the rollers. The adjustment of the rollers with the abnormally wide space therebetween shown in Photograph E, Defendants’ Exhibit B, is trick evidence, but we are satisfied that this Honorable Court will not be deceived by it.

An interesting piece of documentary evidence, which shows that appellant, Bianchi, was in collusion with Superba Packing Co., Ltd., a corporation, one of the defendants in this case before the lower Court, to steal appellee Barili’s invention covered by the patent in suit, is the Declaration of Interference by the Patent Office [Tr. p. 184], between the Barili application for the patent in suit and the application for patent of one Pietro Musio, who was at the time president of the Superba Packing Company, a co-partnership, predecessor of said defendant, Superba Packing Co., Ltd., a corporation. Said defendant Superba Packing Company, a co-partnership, at that time had one of the plaintiff Barili’s ravioli machines [Tr. pp.

103-104]. The interference claim, Count 1 of said Declaration of Interference, is identical with Claim 2 of the Barili patent in suit, and the defendant-appellant, Bianchi, copied the invention of the Barili patent in suit in building his infringing machines for Superba Packing Company and Marlo Packing Corporation, with the *wide* margins around the molds and the cutting means specified in said interference claim, which is claim 2 of the patent in suit [Tr. pp. 103-104]. The file wrapper of the patent in suit does not show what disposition was made of said interference in the Patent Office, but it was obviously determined in favor of the plaintiff-appellee, Barili, because the interference claim, Count 1, appears in the Barili patent in suit as claim 2. The fact that Bianchi took the first Barili ravioli machine sold to Superba Packing Company to his shop and dismantled it and painted numbers on the parts of said machine in order to copy the Barili machine and build an infringing machine which Bianchi sold to Superba Packing Company, characterizes Bianchi as a miserable counterfeiter and a wilful and wanton infringer of the patent in suit. [Tr. pp. 104 and 62.]

*Infringement is a question of fact*, and there is no showing that the holding of infringement by the lower Court is contrary to the *weight of the evidence*.

Walker on Patents (Deller's Ed.), Vol. 3, Sec. 450, p. 1680.

It is submitted that there is no ground for reversal of the lower court's holding of infringement of the patent in suit by the defendants-appellants.

### Alleged Limitation of Action.

The six-year limitation included in R. S. 4921 (U. S. C., Title 35, Sec. 70) does not apply to evidence of infringement as a basis for an injunction, but applies only to evidence of profits and damages. The trial court and this Honorable Court *in this appeal* are concerned primarily with the question of infringement. The question of profits and damages is a matter for an accounting. The lower court properly ruled that evidence of infringement prior to six years before filing this suit was admissible as a basis for an injunction [Tr. p. 63].

The plaintiff-appellee, however, certainly proved by a preponderance of evidence that the defendants-appellants infringed the patent in suit within six years prior to the filing of this suit, and the plaintiff-appellee is accordingly entitled to an accounting of profits and damages, as well as an injunction.

### Conclusion.

It is submitted that the plaintiff-appellee, Barili, made out his case of infringement in the lower court against the defendants-appellants, in accordance with the complaint; that the defendants-appellants failed to establish alleged invalidity of the patent in suit; that the judgment of the lower court should be affirmed, except as to Paragraph 5 thereof concerning profits and damages, from which paragraph of said judgment the plaintiff Barili in the lower court has taken an appeal to this Honorable Court; and that costs should be awarded the plaintiff-appellee.

Respectfully submitted,

ALAN FRANKLIN,  
*Attorney for Appellee, Barili.*









TOPICAL INDEX TO REPLY BRIEF FOR PLAINTIFF-  
APPELLANT, ARTHUR E. H. BARILI

	PAGE
Alleged limitation of action.....	4
Attorney's fee .....	8
Conclusion .....	9

## TABLE OF AUTHORITIES CITED

### CASES

PAGE

Peters v. Hanger, 134 Fed. 586.....4, 7

### STATUTES

Revised Statutes 4921 (35 U. S. C., Sec. 70).....4, 9

### TEXTBOOKS

3 Walker on Patents (Deller's Ed.), Sec. 463, pp. 1699-1700..... 4

No. 11769

IN THE

United States Circuit Court of Appeals  
FOR THE NINTH CIRCUIT

---

ARTHUR E. H. BARILI,

*Plaintiff-Appellant,*

*vs.*

ACHILLE BIANCHI and MARLO PACKING CORPORATION,  
*Defendants-Appellees.*

---

REPLY BRIEF FOR PLAINTIFF-APPELLANT  
ARTHUR E. H. BARILI.

---

In the Brief for Defendants-Appellees, page 25, under the heading "Plaintiff-Appellant's Appeal," it is stated that the *attorneys of record* for plaintiff-appellant are and have been Alan Franklin of Los Angeles and Messrs. Boyken and Beckley of San Francisco. This is of course true at the present time and was true at the time of the regular trial of the case on March 11, 1947. However, it was not true on December 10, 1946, when the motion regarding the taking of a deposition was argued. In the paragraph at the bottom of page 25 and the top of page 26 it is stated that Mr. Beckley, as an attorney of record, should have taken the responsibility of determining the date of the trial, after having been informed that it had been set. The fact is, however, that at the time Mr. Beckley was not an attorney of record, but was only appear-

ing to represent the attorney of record for the plaintiff, Alan Franklin, at that particular hearing concerning taking of a deposition, and consequently at said hearing on December 10, 1946, when the date of the first and irregular trial, February 6, 1947, was mentioned, there was no attorney of record for the plaintiff present, and the responsibility, asserted by defendants' attorney, of Mr. Beckley to notify the plaintiff's attorney of record, Mr. Franklin, was nonexistent [see Affidavits, Tr. pp. 16-18].

It should be noted that the notice of appearance of the case on the Law and Motion Calendar for setting for trial, on December 2, 1946, is not directed to the attorney of record for the plaintiff [Tr: p. 7] and that the notice, that on December 2, 1946, the trial of the case had been ordered set for February 6, 1947, is likewise not directed to the attorney of record for the plaintiff [Tr. p. 8]. Only the defendants' attorneys are named in said notices and plaintiff's attorneys never received those notices or any other notices of the setting of this case for trial on February 6, 1947.

The trial on February 6, 1947, without notice to plaintiff's attorney of record, was most irregular to say the least.

On page 26, last paragraph, of the Brief for Defendants-Appellants, it is argued that "Counsel for plaintiff proceeded with the trial in the usual manner *without in any manner objecting to the* short notice or to his inability to secure witnesses or to his lack of time to prepare for a trial." What else could counsel for the plain-

tiff do but to proceed with the trial of the case, under the most adverse conditions, when the trial court had arbitrarily made its order setting the case for trial on March 11, 1947, the day after plaintiff's attorney arrived in San Francisco from Los Angeles and argued his Motion for Relief From Judgment and to Reset for Trial [Tr. pp. 15, 19 and 44]. Orders are Orders and it is incumbent upon attorneys to comply with court orders, no matter how unreasonable or arbitrary they may be. It should be obvious to this Honorable Court that on such short notice of trial to counsel for plaintiff, who went to San Francisco on March 10, 1947, to argue a motion for relief from an irregular judgment, with no idea or inkling of having to go to trial of the case on less than a day's notice, that in such short time it was impossible to subpoena the books of the defendants and go over them with an accountant to prove *considerable damages* suffered by the plaintiff, by reason of the wilful and wanton infringement by the defendants of the plaintiff's patent in suit. The best that counsel for plaintiff could do in such short time allowed him was to locate two hostile witnesses, Gierth and Cortopassi [Tr. pp. 66 and 88] and get out subpoenas for them to testify to facts concerning infringement, only, of the patent in suit. Said witnesses were not bookkeepers or accountants and could give no accurate testimony concerning damages to plaintiff-appellant by reason of defendants-appellees' infringement of the patent in suit.

### Alleged Limitation of Action.

R. S. 4921 (U. S. C., Title 35, Sec. 70).

The defendants' appellees' witnesses were obviously coached as to the six-year limitation applicable to damages, only, in R. S. 4921, but said witnesses *forgot their lines* in places, and their testimony on the whole was preponderantly to the effect that defendants-appellees infringed the patent in suit *within six years* prior to the filing of this suit on October 19, 1946, and consequently the defendants-appellees failed to carry the *burden of proving* the six-year statute of limitations applicable to damages in patent infringement suits. *The burden of proof is upon the party who pleads the statute of limitations.*

*Peters v. Hanger*, 134 Fed. Rep. 586.

Bianchi testified [Tr. pp. 98-99] as follows:

“Q. \* \* \* Within the last six years, have you made any different from that? A. Yes, I made some rollers with the pocket, the margin, and the cutter all in one roller.”

Such a roller with pockets (molds), margins and cutters all on one roller was a mechanical equivalent of the rollers included in claim 4 of the patent in suit, because it is immaterial where the cutters are placed on the rollers according to Bianchi's testimony [Tr. pp. 97-99].

“Changing the relative position or reversal of parts of a machine or manufacture does not avert infringement.”

Walker on Patents (Deller's Ed.), Vol. 3, Sec. 463, pp. 1699-1700.

Bianchi afterwards testified that he made no ravioli machines in the last six years. Such contradictory testimony of a *party* to the suit, Bianchi, fails to carry the burden of proving the statute of limitations.

Plaintiff-Appellant, Barili, testified that in the summer of 1946 he had a conversation with the witness Herbert Gierth, superintendent of the defendant-appellee, Marlo Packing Corporation [Tr. pp. 66 and 68], in which conversation Gierth stated that said defendant-appellee did not need any machinery for ravioli; that they had a ravioli machine made by the defendant-appellee, Bianchi, exactly like the ravioli machine of the Barili patent in suit, and twice as wide; and that Marlo Packing Corporation had not been using said Bianchi machine for "*five or six months*" prior to the summer of 1946 when the conversation between Barili and Gierth took place [Tr. pp. 68-71]. The statement of Gierth, in the above conversation with Barili, in the summer of 1946 indicates that defendant-appellee, Marlo Packing Corporation, used the infringing Bianchi-Marlo ravioli machine *up to within six months before said conversation* in the summer of 1946, which would bring the infringing use of said machine by Marlo Packing Corporation within the *six year* statute of limitations (R. S. 4921) before filing this suit on October 19, 1946 [Tr. p. 4].

The plaintiff-appellant, Barili, had sold one of his patented ravioli machines to defendant-appellee, Marlo Packing Corporation, about 1933, *but he lost the sale* of another of his machines to said defendant-appellee, because of the sale, by the defendant-appellee, Bianchi, of his infringing machine [Deft. Ex. B] to Marlo Packing Corporation [Tr. pp. 67, 69, 71, 92, 97, and 107]. Such evidence of plaintiff-appellant's loss of a sale of his ma-

chine within the six-year statute of limitations, by reason of the sale by the defendant-appellee, Bianchi, of one of his infringing machines to Marlo Packing Corporation, and the admitted infringing use of said infringing machine [Deft. Ex. B] by defendant-appellee, Marlo Packing Corporation within the six-year statute of limitations, was *proof, at the trial, of damages* to the plaintiff-appellant, Barili, and it was gross error on the part of the trial judge in not assessing the damages or ordering an accounting before a master for such assessment.

The witness Herbert Gierth testified [Tr. p. 67] as follows:

“Q. Did you state you had bought one machine four or five years ago like Mr. Barili’s machine, only twice as wide? A. I told him we bought this ravioli machine from Mr. Bianchi shortly before the war broke out. This machine probably has been in use about *half a year prior to the outbreak of the war*, and then we discontinued it, because we are going into Army and Navy contracts.”

The witness Cortopassi corroborated Gierth [Tr. pp. 88-89] as follows:

“A. The machine was for Marlo Packing Company.

Q. It was built in Bianchi’s shop? A. Bianchi’s shop.

\* \* \* \* \*

Q. About what date was that, do you remember?  
A. The date?

Q. Yes. A. *Before the war*, I guess, *six or seven months.* \* \* \*”



The outbreak of the war in the United States was December 7, 1941, and six months before that date was June 7, 1941. Six years before filing this suit, on October 19, 1946, was October 19, 1940. The building of the Marlo machine by Bianchi and the using of the machine by Marlo was within the six years statute of limitations and said defendants-appellees are liable for damages for infringement of the plaintiff-appellant's patent.

The burden of proving the six-year statute of limitations being on the defendants-appellees has not been carried, and this defense falls to the ground.

*Peters v. Hanger*, 134 Fed. Rep. 586.

The use of the Bianchi machine [Deft. Ex. B] by the defendant-appellee, Marlo Packing Corporation, "*about half a year* prior to the outbreak of the war" (on Dec. 7, 1941), as testified to positively by the witness Gierth [Tr. p. 67], was within the six-year statute of limitations, and the use of said infringing machine for that length of time certainly must have netted the defendant-appellee, Marlo Packing Corporation, a handsome profit, in view of the fact that the machine of the infringed patent in suit is an automatic continuous mass production ravioli machine, *which is at least twelve times faster than any other ravioli producing machine*. This is certainly a matter for an accounting of profits and damages.

The appellees have not only failed to carry the burden of proof that they did not infringe the patent in suit

within six years prior to the filing of this suit, but the evidence clearly shows that such infringement did in fact take place within the period of the statute of limitations, and the appellant, Arthur E. H. Barili, has made out a *prima facie* showing of substantial damages by reason of said infringement of his patent, for which he is entitled to an accounting.

### Attorney's Fee.

The failure of the lower court to award the appellant, Arthur E. H. Barili, a reasonable attorney's fee, in view of the wilful, wanton and aggravated infringement of his patent, over a long period of years, by the unscrupulous appellees, who by such infringement have largely robbed the appellant, Barili, of the fruits of his genius, is in marked contrast to said court's award of a substantial attorney's fee to said appellees, at the irregular one-sided trial of this case on February 6, 1947, without notice to the appellant, Barili, and without due process of law [Tr. pp. 14-15]. If the discretion of the lower court was properly exercised, at said irregular first trial, in awarding an attorney's fee to such unconscionable infringers as the appellees, said court very crudely abused its discretion at the regular trial of the case on its merits, in not awarding a reasonable attorney's fee to the appellant, Arthur E. H. Barili, who has revolutionized the ravioli manufacturing industry by his meritorious invention, and has made a valuable contribution to the science and economy of our country.

### Conclusion.

In conclusion it is submitted that *paragraph 5* of the Final Judgment of the lower court should be reversed; that an *accounting* of the *damages* sustained by the appellant, Arthur E. H. Barili, by reason of the unlawful infringement of his patent in suit by the appellees should be ordered; that such damages should be *trebled* in view of the wilful nature of such infringement; and that appellant Barili should be awarded his costs and a *reasonable attorney's fee*, pursuant to R. S. 4921, (U. S. C., Title 35, Sec. 70).

Respectfully submitted,

ALAN FRANKLIN,

*Attorney for Appellant, Arthur E. H. Barili.*

